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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/797,663	03/09/2004	Michael E. Daniels	4001-0018B (ZM0602)	3929
43232	7590	10/26/2006	EXAMINER	
ZIMMER TECHNOLOGY - ROBERTS			RAMANA, ANURADHA	
P.O. BOX 708			ART UNIT	
WARSAW, IN 46581-0708			PAPER NUMBER	

3733

DATE MAILED: 10/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/797,663

Applicant(s)

DANIELS, MICHAEL E.

Examiner

Anu Ramana

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 5-8, 10, 12, 22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-8, 10, 12, 22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/2/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 8, 22 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Fabian et al. (US 4,936,853).

Fabian et al. disclose a modular knee prosthesis including: a tibial plate 20; an elongated member 10 having an internally threaded socket and a radially projecting shoulder; a tibial insert 30 removably engaged with the superior surface of the tibial plate 20; and a screw 35 extending through the insert and threadably engaged with the elongated member 10 (Fig. 5, col. 3, lines 49-68 and col. 4, lines 1-53).

The method steps of claims 22 and 23 are inherently performed when the Fabian et al. knee prosthesis is custom fitted to a patient for joint arthroplasty.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, 10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabian et al. (US 4,936,853) in view of McCue et al. (US 6,506,216).

Regarding claims 5-7 and 12, Fabian et al. disclose all elements of the claimed invention except for: the base having protuberances including a first generally keel-like portion wherein the first keel-like portion extends radially outwardly relative to the

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through-channel; and a second generally keel-like portion extending radially outwardly relative to the through-channel at an angle of about 180 degrees from the first generally keel-like portion.

McCue et al. teach providing wing elements or "keel-like portions" 26 on the keel or "base" 24 of a tibial tray or plate 12 at varying angles for fixation and positional stability of the prosthesis (Fig. 2 and col. 3, lines 29-36).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided wing elements 26, as taught by McCue et al., in the Fabian et al. prosthesis, for fixation and positional stability.

It is also noted that Applicant has not disclosed a criticality to the angle between the keel-like portions (page 9, lines 7-8).

Accordingly, it would have been an obvious matter of design choice to a person of ordinary skill in the art to provide the first and second keel-like portions in the prosthesis of the combination of Fabian et al. and McCue et al., at an angle of about 180 degrees because Applicant has not disclosed that providing a specific angle between the first and second keel-like portions provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected the prosthesis of the combination of Fabian et al. and McCue et al. and applicant's invention, to perform equally well with either the angle taught by McCue et al. or the claimed "about 180 degrees" because both angles would perform the same function of fixing the tibial plate to the proximal tibia.

Regarding claim 10, it would have been an obvious matter of design choice to one skilled in the art at the time the invention was made construct the socket in the prosthesis of the combination of Fabian et al. and McCue et al. with a hexagonally-shaped portion, since applicant has not disclosed that this solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing. In re Dailey and Eilers, 149 USPQ 47 (1966).

### ***Response to Arguments***

The Terminal Disclaimed filed on August 24, 2006 has been approved. Accordingly, the Examiner is withdrawing the double patenting rejections made in the previous office action.

Applicant's arguments with respect to claims 1, 3, 5-8, 10, 12, 22 and 23, submitted under "REMARKS" in the response filed on August 24, 2006 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR  
October 20, 2006



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER